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In re Application of
ZENG et al.

Application No.: 10/533,623

PCT No.: PCT/CN03/00917

Int. Filing Date: 29 October 2003

Priority Date: 31 October 2002

Attorney Docket No.: 09548.1000USWO

For: A OPTICAL BIOPSY METHOD FOR
PRECANCEROUS LESION DIAGNOSIS AND
AN ENDOSCOPE APPARATUS THEREOF

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Submission of Missing Requirements", filed on 20 January 2006 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Zhouan Huang as inventor in the above referenced application. The requisite \$130 petition fee was paid. The petition is being treated as a petition under 37 CFR 1.497(d).

BACKGROUND

On 29 April 2005, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 07 December 2005, a Notification of Missing Requirements was mailed indicating that an oath or declaration, in compliance 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date, was required.

On 20 January 2006, applicant filed a request to correct the inventorship, to add Zhouan Huang as an inventor. In addition to the \$130 petition fee, Petitioner provided the statement of Zhouan Huang in support of the correction of inventorship under 37 CFR 1.497(d) and a declaration executed by the joint inventors along with the \$65 surcharge for filing the declaration after the thirty month period.

DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).

Applicants provided a statement, signed by Zhouan Huang, stating that "I was omitted as an inventor in the PCT application in error. I state the error in inventorship in the international application occurred without deceptive intent on my part". This statement satisfies item (1) of 37 CFR 1.497(d).

The processing fee of \$130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), a review of the application file reveals that an assignment of assignors interest was filed with the USPTO on 17 January 2006. However, applicant has not provided a Written Consent of Shanghai Shengbio Science and Technology Co., Ltd. (assignee) to correct the inventorship under 37 CFR 1.497(d)(3) consenting to the addition of Zhouan Huang as an inventor in this application. Item (3) above has not yet been satisfied.

Accordingly, applicant has not met all of the requirements to add Zhouan Huang as co-inventor in the above-identified international application.

CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Zhouan Huang as co-inventor is hereby DISMISSED WITHOUT PREJUDICE.

The application will be held in the PCT Legal Office to await applicant's further reply.

Any reconsideration on the merits of the petition under 37 CFR §1.497(d) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.497(d)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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